

United States
COURT OF APPEALS
for the Ninth Circuit

HARRY X. BERGMAN, PERMA-LOX
ALUMINUM SHINGLE CORPORA-
TION, Doing Business Under the As-
sumed Name of Langville Manufac-
turing Company,

Appellants,

vs.

ALUMINUM LOCK SHINGLE CORPO-
RATION OF AMERICA,

Appellee.

APPELLEE'S SUPPLEMENTAL BRIEF

*Appeal from the United States District Court for the
District of Oregon.*

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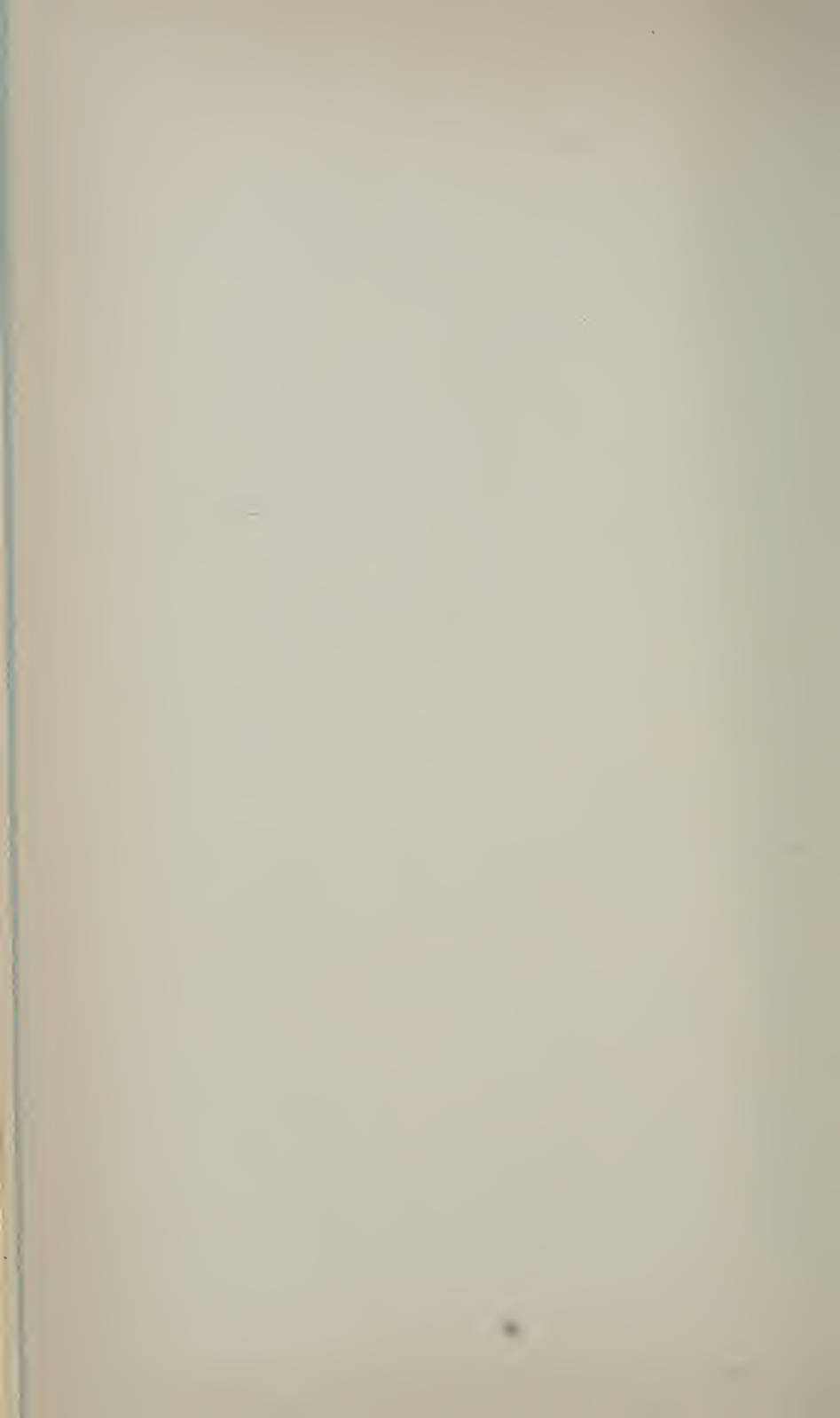
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APPELLEE'S SUPPLEMENTAL BRIEF

*Appeal from the United States District Court for the
District of Oregon.*

This brief is supplemental to the brief submitted on the former appeal to be considered in connection therewith. (Former Opinion, 237 F. 2d, 386).

PRELIMINARY STATEMENT

The first application for the patent involved herein, was filed September 26, 1947. (Serial No. 776,332).

After various proceedings in the Patent Office, an amended application was filed on **January 9, 1956**. (Serial No. 137,566).

The patent was **granted on both applications** March 17, 1953, Patent No. 23,631,552.

The patent recites (lines 1 to 9):

“This invention relates generally to shingles and particularly to aluminum shingles as set forth in detail in my **co-pending application, Serial No. 776,332**, filed September 26, 1947, over which the shingle shown herein is **an improvement**.

“The **main object** of this invention is to devise a metal shingle of the interlocking type in which provision is made to **prevent leakage from heavy run-off, on condensation, or both.**”

Plaintiff, as assignee of Korter, the patentee, commenced to manufacture and market the shingle contemporaneously with the filing of the first application and has continued to manufacture and sell the same ever since.

Bergman lived in Portland, Oregon, where the patentee and plaintiff reside.

Bergman became interested in the aluminum shingle business in the spring of 1952 (Tr. 227), long after the amended application was filed. Bergman came in contact with plaintiff in July 1950, at which time he purchased, and plaintiff installed on his house, an aluminum shingle roof (Tr. 152). Bergman was, at the time, and still is, engaged in operating women's ready-to-wear clothing stores.

The striking similarity of the Bergman shingle to the patented shingle is, of course, obvious and

highly significant and, aside from the legal questions involved, demonstrates the intention and purpose to pirate plaintiff's invention.

It is also significant that Bergman did not simulate any of the shingles allegedly covered by the prior art ("paper") patents which he claims anticipated the Korter Patent (**Byers Mach. Co. v. Keystone Driller Co.**, 44 F. 2d 283, 6th Cir.)

The resemblance was not accidental as sometimes occurs when two or more inventors, unknown to each other and located in different parts of the country, conceive the same idea and attempt simultaneously or at different times to put them into operation without being aware that the idea had already been conceived and put into practical use and operation. In the case at bar, the simulation was deliberate.

Bergman launched the business of making and selling the shingle which "simulated" the patented shingle as he became aware of its commercial success. (**Coleman Company v. Holly Mfg. Co.**, 233 F. 2d 71, 9th Cir.)

It is also significant that Bergman did not testify that the accused shingle was "derived either from the prior art or by independent experiment." (**Graver Tank & Mfg. Co. v. Linde Air Products Co.**, 336 U.S. 271) and warrants the inference that the accused shingle is the "result of imitation." (Same case, 339 U.S. 605.)

I.

RE: VALIDITY OF PATENT**POINTS AND AUTHORITIES**

A.

The Presence in Prior Patents of One or More Elements Found in Plaintiff's Combination Patent, Does Not Render It Invalid. It Is the Combination That Is New. Such a Combination Is Not Shown in Any of the Patents Relied on by Defendants.

- 69 C.J.S. 199, sec. 21;
- Brown & Co. v. De Bell, 243 F. 2d 200 (9th Cir.);
- Coleman v. Holly Mfg. Co., 233 F. 2d 71 (9th Cir.);
- Pointer v. Six Wheel Corp., 177 F. 2d 153 (9th Cir.);
- Bianchi v. Barili, 168 F. 2d 793 (9th Cir.);
- Bates v. Coe, 98 U.S. 31;
- Imhaeuser v. Buerk, 101 U.S. 647;
- Jeoffroy Mfg. v. Graham, 206 F. 2d 772 (5th Cir.);
- Florence-Mayo Co. v. Hardy, 168 F. 2d 778 (4th Cir.);
- Cameron Iron Works v. Stekoll, 242 F. 2d 17 (5th Cir.);
- Application of Hummer, 241 F. 2d 742 (U.S. C.C. P. A.);
- Zonolite Co. v. U. S., 149 F. Supp. 953;
- Holstensson v. Webcor, Inc., 150 F. Supp. 441;
- Hemphill Co. v. Holeproof Hosiery Co., 143 F. Supp. 727.

B.

Invalidity Must Be Established by Proof Beyond a Reasonable Doubt.

Stoody Co. v. Mills Alloys, 67 F. 2d 807 (9th Cir.);
 Bianchi v. Barili, 168 F. 2d 793 (9th Cir.);
 Heinz Co. v. Cohn, 207 Fed. 547 (9th Cir.),
 (followed with approval, Radio Corp v.
 Radio Eng. Lab., 293 U.S. 1);
 Mumm v. Decker & Sons, 301 U.S. 168;
 Patterson-Ballagh Corp. v. Moss, 201 F. 2d
 403 (9th Cir.);

C.

**Defendant Has Particularly Heavy Burden
 When Validity Is Sustained by Trial Court Findings.**

Bianchi v. Barili, 168 F. 2d 793 (9th Cir.);
 Collins v. Kraft, 144 F. Supp. 162;
 Mumm v. Decker & Sons, 301 U.S. 168.

D.

**The Presumption of Validity Which Attaches
 to the Patent Arises From the Expertness of the
 Administrative Agency Issuing the Patent and Can
 Be Overcome Only by Clear and Convincing Evidence.**

35 U.S.C.A., sec. 120;
 Massa v. Jiffy Products Co., 240 F. 2d 702
 (9th Cir.).

E.

**The Presumption of Validity Is Entitled to
 Greater Weight Because the Patent Was Issued
 Over Prior Act Patents Cited in the Patent.**

Bianchi v. Barili, 168 F. 2d 793 (9th Cir.);
 Holstensson v. Webcor, Inc., 150 F. Supp.
 441;
 Brown v. Brock, 240 F. 2d 723 (4th Cir.);
 University of Illinois Foundation v. Block
 Drug Co., 241 F. 2d 6 (7th Cir.);

Paragon-Revolute Corp. v. C. F. Pease Company, 239 F. 2d 746 (7th Cir.).

F.

Commercial Success of the Patent Strengthens the Presumption of Validity and Is of Great Importance in Determining the Issue of Validity.

Brown & Co. v. De Bell, 243 F. 2d 200 (9th Cir.);

Stoody Co. v. Mills Alloys, 67 F. 2d 807 (9th Cir.);

G.

"Imitation" of the Patented Process Aids the Presumption.

Bankers' Utilities Co. v. Pacific Nat. Bank, 18 F. 2d 16 (9th Cir.);

Florence-Mayo Co. v. Hardy, 168 F. 2d 778 (4th Cir.).

H.

The Presumption of Validity Is Reenforced by Expert Evidence in the Case at Bar. There Is No Expert Evidence to Contrary.

University of Illinois Foundation v. Block Drug Co., 241 F. 2d 6 (7th Cir.);

General Electric Co. v. Germania Electric Lamp Co., 174 Fed 1013.

I.

Resurrection of "Dormant," Old "Paper Patents" Not Put to "Commercial Practice," Is of Little or No Value.

Pointer v. Six Wheel Corp., 177 F. 2d 153 (9th Cir.);

Campbell v. Mueller, 159 F. 2d 803 (6th Cir.);

Wahl Clipper Corp. v. Andis Clipper Co., 66 F. 2d 162 (7th Cir.);
 Priebe & Sons Co. v. Hunt, 188 F. 2d 880 (8th Cir.).

J.

The Birch Patent Cannot Be Considered Because It Was Not Admitted into Evidence. It Was Not Included in Defendants' Contentions in the Pre-Trial Order (Which Superseded the Answer) or in the List of Exhibits in the Pre-Trial Order and No Expert Testimony Was Introduced by Defendants as to Its Application.

Watson v. Rhode Island Ins. Co. 196 F. 2d 254 (5th Cir.).

Rule 75 (g), F.R.C.P.

Bell v. MacKinnon, 149 Fed. 205.

Reverse Stitch Co. v. California Reverse Stitch Co., 81 F. Supp. 976 (D.C. Cal.).

K.

The Question of Invention, Validity, Combinations Providing New and Useful Results, Anticipation and Infringement, Are All Questions of Fact.

Faulkner v. Gibbs, 170 F. 2d 34 (9th Cir.).

ARGUMENT

Appellants' contentions are all predicated on a basic erroneous hypothesis that the patent only covers "a hole," referring to the opening in the gutter near the bottom corner of the shingle.

The patent covers a combination of several elements, all of which are **inter-related**, depending upon each other to accomplish a new and useful

improvement in aluminum shingle construction, the ultimate object of which is to prevent condensation water (forming on the under-side of the roof shingles) from dripping into the building and diverting it so that the condensation water will drain from the **under-side** of the shingle **to the outside** of the next lower shingle and down to the roof gutter. As set forth in the Patent (lines 5 to 9):

“The main object of this invention is to devise a metal shingle of the interlocking type in which provision is made to prevent leakage from heavy run-off, on condensation, or both.”

The patent recites that it covers “one claim” and recites the several elements forming the combination that produces the new “unitary” result.

The patent does not cover each element enumerated therein as a separate claim independent of the others. It is only the combination and the result achieved thereby that is patented.

Appellants attack the validity of the patent by asserting that one or another (not all) of the elements that are included in the Korter combination is present in one or another of the prior patents. Appellants do not point to any patent that purports to cover a combination.

Assuming, without admitting, that one or more elements may be present in one or more prior patents, that would not render the Korter combination patent invalid.

Appellants stubbornly refuse to recognize that the patent covers a combination of elements so designed, arranged, and perfected as to produce a

new and novel unitary result in which a "drain slot" is merely one of the several elements, all of which must exist in combination to produce the ultimate object of the invention.

The patent does not describe "a hole" as one of the elements. It describes,

"a **drain slot** disposed in the gutter of said shingle for draining water therefrom."

It does not require the "drain slot" to be in any particular form or in any particular place. It requires only that the "drain slot" should be disposed in the gutter. It could be anywhere in the gutter, including the end.

In *Coleman Co. v. Holly Mfg. Co.*, 233 F. 2d 71 (9th Cir.), the Court held:

"As far back as 1878 the Supreme Court, in a leading case, pointed out that the separate presence of the elements of a combination in three or four other patents in the prior art does not preclude a finding of invention when these elements are later so combined as to produce a **new or better result**. Judge Yankwich applied this principle in *Kammerer Corp. v. McCullough*, D.C., 39 F. Supp 213, at page 216. His judgment in that case was affirmed by this Court In adhering to the principle above noted, the trial judge adopted language found in *Bates v. Coe*, 98 U.S. 31, 48, 25 L.Ed. 68 where the Court says:

"Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and

another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.' "

In **Pointer v. Six Wheel Corp.**, 177 F. 2d 153 (9th Cir.) this Court held:

" invention cannot be defeated merely by showing that, in one form or another, each element was known or used before.

.

"The question is: Did anyone before think of combining them in this manner in order to achieve the particular unitary result,—a new function? **If not, there is invention.**" (Citing many cases of this and other Courts.)

None of the patents, relied on by defendants, were combination patents combining elements to produce the ultimate unitary result contemplated by the Korter Patent, to-wit, draining the condensation from the under-side of the shingles to the outside of the lower shingles. This was the "new function." As was said by this Court in the **Pointer case**, no one thought of

"combining them (elements) in this manner to achieve the particular unitary result—a new function."

In **Bianchi v. Barili**, 168 F. 2d 793 (9th Cir.), the Court held:

" 'It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty; and we think that the combination of elements by which this was effected, **even if those ele-**

ments were separately known before, was invention sufficient to form the basis of a patent.' " (Emphasis supplied.)

In *New York Scaffolding Co. v. Whitney*, 224 Fed. 452 (8th Cir.), the Court held:

"The rule is now well established, by sound reasons and the great weight of modern authority, that it is not requisite to the patentability of a combination of old mechanical elements that each element should, in addition to performing its own function, modify the function performed by one or more of the other elements of the combination. It is sufficient if the combination of the old elements is new, and if the combined elements are capable of producing a novel and useful result, or an old result in a more facile, economical, or efficient way (citing many cases).

.

"A new combination of old elements, in which, by a different location of one or more of the elements, a new and useful result is attained, or an old result is produced in a better way, is patentable (citing cases).

.

"The combinations of Henderson's first and third claims were new. No one had made them before he disclosed them. They were not described or suggested in the prior art.

.

"These new and beneficial results were the effects, not of the separate performance by each of the old elements of its own function, but of the new relation and the new method of combination of the old mechanical elements, and of their cooperation in that relation in the combinations of Henderson. Those combinations, therefore, fall well within the line of patentability established by reason and authority."

In **Jeoffroy Mfg. Co. v. Graham**, 206 F. 2d 772 (5th Cir.), the Court held:

" . . . we think the fact that some of the elements in Graham were admittedly known to the prior art still would not preclude its validity, or negative any invention therein, so long as the Graham combination produces a new and useful result in a substantially different way (citing cases). We think the basic fallacy of appellants' position as to the lack of invention in Graham lies in their attempt to show anticipation by separating the entire combination into its component elements and, in the light of hindsight, to expose them piecemeal as already known to the agricultural art. This form of attack on the validity of a patent received early disapproval by the Supreme Court in *Parks v. Booth*, 102 U.S. 96, 104, 26 L.Ed. 54; see also *Williams Iron Works Co. v. Hughes Tool Co.*, 10 Cir., 109 F. 2, 500, 506. We think appellants fail to give due consideration to the fact that the District Court not only found novelty in certain structural features of the Graham device, but further found that the combination itself produced a new and useful result which amounted to invention."

In **Florence-Mayo Nuway Co. v. Hardy**, 168 F. 2d 778 (4th Cir.), the Court held:

"There is nothing in the prior art which anticipates this combination. The tobacco barn, the arrangement of tobacco and the ventilator in the roof were old. Likewise old were the admission of air from the outside, the use of open flame burners for heating purposes and the provision of a hood over the burners. What was new was the combination of these with a device for delivering the outside air under the hood and over the burners. It was this that accomplished the desired result; and such a combination was nowhere shown in the prior

art. As in most infringement cases of this sort, many of the things which the patentee has brought together can be found separately in the art; but nowhere are they found in the combination which brought success to the patentee."

In **Robert W. Brown & Co. v. De Bell**, 243 F. 2d 200 (9th Cir.), the Court held:

"In our opinion, none of the prior art embraces, in substantial respects, the combination of features which lend novelty and invention to the design in question."

In **Patents**, 69 C.J.S. 199, title: **Combinations**, Sec. 21, the text says:

"It is indispensable that all of the elements, or their mechanical equivalents be found in the same description, method, or device, where they have been combined in substantially the same way to produce substantially the same result as that accomplished by the combination of the invention; and, where no single device, patent, or publication in the prior art discloses all the elements of a combination, there is no anticipation. To find in the prior art each element in isolation is not to anticipate the work of an inventor who first evolves a new combination of those elements which by their conjoined functions produce a new result; anticipation cannot be shown by reference to one prior device, patent, or publication for one part of an invention and to another device, patent, or publication for another. A combination of all the elements but one will not anticipate; and the substitution in a combination, of an old element which has never previously been used in such a combination, in place of another old element which had previously been used in such combination, may render the combination patentable."

In **Bates v. Coe**, 98 U.S. 31 (recognized by this Court as the leading case, 233 F. 2d 71), the Court held:

“Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.”

In **Imhaeuser v. Buerk**, 101 U.S. 647, the Court held:

“Before entering upon a separate examination of these several patents, it is proper to remark that it is not pretended that any one of them embodies the entire invention secured to the complainant in his letters-patent. Nothing of the kind is pretended, but it is insisted that each contains some feature, device, or partial mode of operation corresponding in that particular to the corresponding feature, device, or partial mode of operation exhibited in the complainant's patent.

“Suppose that is so, still it is clear that such a concession cannot benefit the respondent, it being conceded that neither of the exhibits given in evidence embodies the complainant's invention or the substance of the apparatus described and claimed in his specification. Where the thing patented is a entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of in-

fringement by alleging or proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another prior exhibit, and still another part in a third exhibit, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement. **Bates v. Coe**, 98 U.S. 31, 48."

In **Cameron Iron Works v. Stekoll**, 242 F. 2d 17 (5th Cir.), the Court held:

" that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art."

In **Holstensson v. Webcor, Inc.**, 150 F. Supp. 441, the Court held:

"A patented combination cannot be anticipated piecemeal by finding individual features separately in the prior art. **Imhaeuser v. Buerk**, 101 U.S. 647, 660, 25 L.Ed. 945; **Bates v. Coe**, 98 U.S. 31, 48, 25 L.Ed. 68.

"A new combination of old elements whereby an old result is obtained in a more facile, economical and efficient way, or whereby a new and useful result is achieved may be protected by a patent as securely as a new machine or composition of matter."

In **Zonolite Co. v. U. S.**, 149 F. Supp. 953, the Court held:

"An improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where, as here, it produces a useful result in a cheaper and otherwise more advantageous way. See **Jeoffroy Mfg., Inc., v. Graham**, 5 Cir., 1955, 219 F. 2d 511."

In **Hemphill Co. v. Holeproof Hosiery Co.**, 143 F. Supp. 727, the Court held:

“While separate elements of the claim in suit may be found in separate prior art references, there is nothing in the prior art to suggest their correlation and interaction in the method and apparatus claimed. The combination of these elements as defined in the claims in suit is new.”

Everything about the Korter shingle, its shape, form, corrugations, indentations, etc., was included, designed and arranged in sequence to perform an important function contributing to the accomplishment of the ultimate new object. Without the presence of any one of said elements, the ultimate object could not be accomplished. Each of the elements are designed to insure that the condensation water will ultimately be discharged upon the outside of the new lower shingle through the drain slot in the gutter.

The presence of the indentations or grooves, running longitudinally, are introduced for the purpose of acting as channels which will drain the condensation forming on the under-side of the shingle down along the surface of the shingle to the S shaped gutter formed at the bottom of the shingle.

If the surface of the shingle were left flat, the condensation water would drop from the surface of the shingle into the building.

The three vertical indentations in the shingle, **depressed downward for the full width** of the shingle, were made designedly to accomplish two important purposes. They form legs. They are

deeper than the corrugations covering the surface of the shingle and the ends are extended to the bottom so that when the ends rest upon the flange of the next lower shingle, there will be a space between the lower end of the shingle and the flange upon which the legs rest so that the water could drain into the gutter. If these legs, or indentations, were absent, or did not extend low enough to rest on the flange of the next lower shingle, the water on the under-side of the shingle would not drain into the gutter, but would fall off into the interior of the building.

The S flanges, at the top and bottom of the shingle, are not introduced merely to engage the ends of the shingle. They are so designed in the S shape with round bottom to create the gutter at the bottom of each shingle into which the condensation will flow and be drained through the drain slots and, at the same time, engage each other firmly. A flat flange, which would merely engage the two shingles (Crawford Patent) would prevent the accumulation of the condensation water and its drainage into the drain slot.

It took ingenuity and resourcefulness to design each element and combine them so that each would have the proper relation to the other element to the end that in combination they would accomplish the declared object of the invention.

The drain slot, in itself, would be a useless device without the other elements which are all designed to insure the diversion of the condensation water to the drain slot. While a drain slot is the ul-

timate means of evacuating the water from the under-side of the shingle to the outside of the roof, **the particular type of drain slot is not the important or controlling element.** It is the **existence of a drain slot** adequate to discharge the water that is important. It is immaterial whether that result is accomplished by a drain slot consisting of a hole in the gutter near the end of the shingle or is accomplished by snipping off the corner of the shingle to create the drain slot or hole as Appellee describes it. The patent does not say that the "drain slot" must be a "hole" or that it should be in any particular place in the gutter. It only says, **"a drain slot disposed in the gutter for draining water therefrom."**

Re: Birch Patent

The Birch Patent, on which defendants now strongly rely, cannot be considered. It was not included in the Pre-trial Order in support of its contention of anticipation. It was not included in the list of exhibits in the Pre-trial Order. The Pre-trial Order superseded the answer (Tr. 46). **It was not introduced or admitted in evidence.** It is not a part of the record in this case and **no testimony was introduced by defendants concerning the Birch Patent.**

This condition clearly warranted and compelled the finding of fact (Tr. 49-50) that the Birch Patent did not anticipate the Plaintiff's Patent.

Rule 75, Federal Rule of Civil Procedure, provides:

“The matter so certified and transmitted constitutes the record on appeal.”

This Rule precludes consideration of documents as exhibits which were not admitted in evidence and not certified as a part of the record on appeal.

In *Watson v. Rhode Island Ins. Co.*, 196 F. 2d 254, appellant transmitted to the Court, by attaching to its brief, a document which was not admitted in evidence. Appellee moved to strike the exhibit from the brief. The Court held:

“ we think it plain: that the appellee’s motion to strike exhibits now tendered for our consideration should be granted; that the appeal should be determined on the record made below; and that, on that record, the judgment was soundly based, and should be affirmed.”

The Birch Patent was not a “combination” of a number of elements. **It did not deal with the problem of condensation at all.** It was designed to make a “water tight joint” to keep rain out. No provision is made for drainage of condensation water from the **under-side to the outside.**

Invalidity for anticipation cannot be predicated in this Court for the first time on the Birch Patent which was abandoned in the Court below by the Pre-trial Order and was not introduced or admitted in evidence and not considered by the Trial Court.

Even if this Court could try the case de novo, it could not consider the Birch Patent because it is not a part of the record. This is not a case of inadvertent omission of a document in making up the record in this Court which was introduced and

admitted in evidence in the Trial Court. In this case, defendants deliberately excluded the Birch Patent from the record and plaintiff was deprived of the opportunity to cross-examine defendants' witnesses on this patent and to introduce evidence to demonstrate its inapplicability.

Re: Belding Patent

The only patent referred to by defendants in which the subject of condensation is even mentioned, is the Belding Patent (DX 37). That patent recognizes the problem of "sweating" or condensation which forms on the under-side of metal shingles due to differences of temperature and that it presents "serious disadvantages" in the present form of metallic shingles."

But Belding did not devise a means of **draining** off the condensation water. His object was to **prevent the formation** of the sweat or condensation by providing adequate ventilation. It says:

"it is an object of my invention to provide a roof construction wherein light weight metallic shingles are employed **in combination with a roof** sheathing in such a manner as to permit the free circulation of air between the shingles and the sheathing for the purpose of **eliminating sweating.**"

The Belding Patent does not cover the **shingle itself**. It covers a shingle "in combination with roof sheathing" and it does not deal with the problem of evacuating the condensation water from the under-side of the shingle to the outside of the roof. It is designed only to introduce

“free circulation of air . . . for the purpose of **eliminating** (the formation of) the condensation.” (Matter in parenthesis supplied.)

These problems and objects of the invention are entirely different from the object of the plaintiff's patent which deals with the draining off of the condensation water and not with the prevention of the formation of condensation water.

In the Belding Patent, the use of

“strips or boards of insulating material” (p. 1, line 52)

in connection with the metal shingle, is an **integral part** of the patent. At page 2, lines 22 to 25, the patent recites:

“the means by which sweating is eliminated is clearly illustrated. The shingles 1 are herein shown as applied over pulp-board sheathing or the like,”

At page 2, lines 45 to 50, the patent says:

“To eliminate sweating or the accumulation of moisture between the shingles and adjacent sheathing, . . . provision for the circulation of air between the shingles and the sheathing is provided by the grooves 16 . . .”

Re: Other Patents

Defendants admitted that the patents they relied upon, did not involve a “combination” of elements (Tr. 241).

While the Expert Richardson was testifying to the elements making up the combination, Mr. Kolisch said:

“Your Honor, the defendants object to this line of questioning. In the defendants’ case we didn’t put in anything concerning the combination and aggregation of elements in the Korter patent. We don’t believe that this is proper rebuttal,”

All patents relied on by defendants were designed to prevent rain from backing into the building. For that purpose, they all provide for watertight seams. None dealt with the disposition of “condensation” water that forms on the under-side and its drainage to the outside.

Ten patents were introduced into evidence by defendants. They are:

Lewando No. 1	Clawson
Lewando No. 2	Pruden
Slaughter	Belding
Cusack	Miller
Crawford	De Sincay (British)

As to six of these patents, to-wit:

Lewando No. 1	Cusack
Lewando No. 2	Clawson
Slaughter	De Sincay

defendants **did not introduce any evidence whatsoever** tending to establish anticipation.

In **Bell v. MacKinnon**, 149 Fed. 205 (2nd Cir.), the Court

“ anticipation is claimed, but the defense is only suggested by injecting a large number of prior patents into the record without any explanatory testimony, and, apparently for this reason, the court below has filed no opinion, except a statement that the claim in suit is valid and infringed. If an examination of the prior art were necessary to the

decision of the case, we should not sustain the defense of anticipation upon such mere production of patents for complicated combinations of machinery."

As to the remaining four patents, to-wit:

Crawford
Pruden

Belding
Miller

defendant Langville gave some testimony purporting to show similarity with respect to one or more distinct elements.

This testimony had no probative value and did not even tend to establish anticipation as will be presently demonstrated.

In *Reverse Stitch Mfg. Co. v. California Reverse Stitch Co.*, 81 F. Supp. 976, the Court held:

"The defendant offered no evidence to explain or interpret the Leilich patent, and in the absence of such evidence this court is not bound to consider the same. *Bell v. MacKinnon*, 2 Cir., 149 F. 205."

Langville merely attempted to show the presence of one or another of the several elements present in plaintiff's combination patent that were also present in the one or the other of the **four named** patents. He did not attempt to show that any of the four patents contained, **in combination**, all of the elements shown in plaintiff's patent and essential to the attainment of the object of the plaintiff's patent.

Three of the four patents, as to which he testified, did not even mention the problem of condensation. The Belding Patent did deal with the problem

of condensation, but as already pointed out, it dealt **not with the drainage** of the condensation water, but the **prevention of the formation** of sweat or condensation.

As against this nebulous testimony of defendant Langville, the plaintiff introduced expert evidence through Max G. Richardson, a qualified engineer, who demonstrated the creation of the combination patent by the development of the several elements, all interrelated, to accomplish the ultimate object of draining the condensation water from the under-side of the upper shingle on to the outside of the next lower shingle. He showed what each function of the elements was designed to perform; the sequence of the elements; the relation of one to the other, and the interdependence of all of them upon each other to accomplish the ultimate result.

Mr. Richardson then took each of the ten patents that defendant introduced into evidence and demonstrated beyond question:

- (a) that none of them involved a combination of elements;
- (b) that none of them (except the Belding patent) dealt with the problem of disposing of condensation water; and
- (c) that none of them contained any of the elements involved in the plaintiff's patent.

Whatever issue of fact may have presented itself by Langville's testimony concerning the four patents that he dealt with and the testimony of Mr. Richardson as to all of the patents, was determined by Judge Fee adversely to the defendants and his

finding of fact No. X (Tr. 49) that the patents relied on by defendants, did not anticipate plaintiff's patent, is supported by the overwhelming weight of the evidence.

The lack of probative value in the testimony of Langville on the subject of anticipation can be readily seen from the following illustration. Judge Fee was fully justified in refusing to give credence to his testimony.

One of the most important elements in plaintiff's patent is the S shaped gutter along the lower edge of the shingle designed to catch the condensation water and lead it to the drain slot for discharge on the outside of the next lower shingle. Langville attempted to show that this element was present in the Crawford Patent. He testified on direct examination (Tr. 190):

"Q. Does the Crawford shingle have a gutter?

A. Yes, it has.

Q. Is there any provision for drainage in the Crawford shingle?

A. Whenever the shingles are locked together you can't get a perfectly tight joint, and naturally there would be some drainage."

He then proceeded to give a demonstration from an assembly of what purported to be the Crawford shingles made by defendants. In the shingles that were used for that demonstration, the shingles engaged each other loosely so that water could be caught in the up turned flanges.

He did this, notwithstanding the fact that the Crawford Patent makes no provision for a gutter

of the S or any other type and specifically provides:

“when the shingles are fastened together, will be perfectly waterproof; (p. 1, lines 13 and 14)

.

All the folded edges fastened together are **hammered down, so as to be substantially flat and perfectly waterproof.**” (p. 1, lines 98 to 100.)

In the shingles used in the demonstration, the folded edges were not **“fastened together”** and **“hammered down”** “to be perfectly waterproof.” This hammering down process to flatten the shingles and make them waterproof, of course, ultimately destroyed the use of the turned flanges as a gutter for catching and draining the condensation water and effectually prevented the condensation water from draining to the outside of the next lower shingles. The presentation of the demonstration without the flattening of the flanges was a deception.

On cross-examination, when confronted with the provision in the Crawford Patent that required hammering down of the flanges to make a flat water tight seam, he attempted to squirm out of the predicament by asserting,

“If the overturned edges were hammered down on the roof, where it would be installed, I doubt very much that the metal would close perfectly tight. . . .” (Tr. 210-211).

His attention was then called to the fact that his testimony was contrary to the language of the Crawford Patent which states that the hammering

down and flattening would produce a water tight seams (Tr. 212), and he testified (Tr. 213):

“Q. Is it your opinion, sir, that Crawford could not accomplish the very thing that he set forth in his specifications, which was to make a ‘perfectly waterproof’ roof?

.

A. I believe **I am going to disagree with Frederick Crawford.** It would not be practical to try to hammer a roof down, every joint, because you couldn’t make it perfectly waterproof unless you do solder the joints.”

In other words, he first asserted that Crawford anticipated the Korter Patent, at least insofar as it provided for an **S shaped gutter with a drain slot at the end**, and wound up by stating that the Crawford Patent could not do what it was designed to do, namely, to provide a water-tight seam.

Mr. Richardson, in rebuttal, showed that the demonstration put on by Langville with the Crawford shingles, was not a fair demonstration because the flanges had not been hammered down flat and made water tight (Tr. 248-250). Of course, if the flanges had been flattened and made water-tight, the water applied to the under-side of the Crawford shingles by Langville in the demonstration, would not have drained to the outside of the next lower shingle. There would have been no channel or gutter to accomplish that purpose. He also demonstrated that the Crawford shingle does not show any drain slots in the drawings or in the specifications or claims.

The reason for Jurge Fee’s rejection of Langville’s testimony is obvious.

Defendant Langville tried to establish anticipation by showing that water would drain because of the accidental inability (contrary to the Crawford express declaration) to make a water-tight seam by hammering down the flanges.

The accidental result, not intended, cannot constitute invention and anticipation by Crawford.

In **Eibel Process Co. v. Minnesota & Ontario Paper Co.**, 261 U.S. 45—43 S. Ct. 322, the Court held a result brought about:

“ . . . under unusual conditions, accidental results, not intended and not appreciated, do not constitute anticipation. *Tilghman v. Proctor*, 102 U.S. 707, 711, 26 L.Ed. 279; *Pittsburgh Reduction Co. v. Cowles Electric Co. (C.C.)*, 55 Fed. 301, 307; *Andrews v. Carman*, 13 Blatchford, 307, 323, Fed. Cas. No. 371.”

Re: Miller Patent

In reference to the Miller Patent, Langville testified that it disclosed an “S type” lock (Tr. 194), but went on to say:

“Well, I wouldn’t say so, because that impression is very light, only to turn up so that one would lock into the other.” (Tr. 195.)

This, of course, was not a persuasive answer to the question whether the Miller shingle had an S type lock.

He also testified that neither the Crawford nor the Miller Patents have drain slots. He said:

“No, there is no drain slot fabricated in the metal.” (Tr. 197.)

He also testified that he saw nothing in the Miller Patent "about condensation" (Tr. 205).

In Miller, the grooves bulge out and do not run to the bottom. They are not designed to and cannot act as legs to keep the shingle from laying flat on the next lower shingle to allow for drainage into the gutter.

The "ridges" are for architectural effect only (lines 30 to 40 Miller Patent), not for utility as an integral part of the drainage function.

In the case at bar, the validity of the patent is established:

- (a) by the statutory presumption of validity;
- (b) by the fact that none of the patents relied on by defendants were combination patents;
- (c) by the fact that none of the patents, except the Beldon Patent, dealt with the problem of condensation;
- (d) The Belding Patent did not deal with the drainage of condensation, but dealt only with the problem of preventing the formation of condensation;
- (e) there was expert testimony on behalf of the plaintiff demonstrating that there was no anticipation and that there was novelty of the highest probative value;
- (f) there was no expert testimony having any probative value on the subject of anticipation and novelty. In fact, defendants concededly introduced no testimony relating to the combination.

The defendants' evidence on the subject of anticipation and invalidity was so nebulous, and the

distinction between the cited patents and the plaintiff's patent, are so obvious that Judge Fee did not deem it necessary to write any opinion.

The presumption of validity is greatly strengthened by the fact that the patent was issued over a number of patents cited in the Patent, all of which the defendants rely upon. The issuance of the combination patent was an adjudication by the Patent Office that none of the cited patents anticipated the Korter combination.

In **Faulkner v. Gibbs**, 170 F. 2d 34 (9th Cir.), the Court held:

“(4) The question of whether or not a **new and useful combination** is the result of mere mechanical skill, or if inventive faculty, is one of fact.

“(5) **What constitutes invention** as distinguished from a mere aggregation, is a question of fact.

“(6) Questions of invention and patent **validity** are questions of fact.

“(7) **Whether prior art, patents** or publications disclose or **anticipate** the subject matter of a patent in issue is determined as a question of fact.

“(8) The issue of **infringement** present a question of fact.”

In **Bianchi v. Barili**, 168 F. 2d 793 (9th Cir.), the Court held:

“ ‘The presumption of validity is strengthened by the circumstances that the alleged anticipating patent was considered by the Patent Office in connection with the application for the patent in suit.’ ”

In **Stoody Co. v. Mills Alloys**, 67 F. 2d 807 (9th Cir.), the Court held:

“Again in **Bankers’ Utilities Co. v. Pacific Nat. Bank**, 18 F. 2d 16, 18, the late Judge Dietrich, also of this court, observed: ‘In their position plaintiffs are fortified by the presumptions attending a patent * * * and by the fact that their device is a commercial success and has brought on imitation. (Many cases cited on each point).’ ”

In **Robert W. Brown & Co. v. De Bell**, 243 F. 2d 200 (9th Cir.), the Court held:

“Commercial success is of great importance in determining the validity of a design patent. **Glen Raven Knitting Mills, Inc., v. Sanson Hosiery Mills, Inc.**, 4 Cir., 189 F. 2d 845. This is so because the objective of most such designs is to enhance saleable value. The realization of this objective shows that the design must have been sufficiently novel and superior to attract attention.”

The presumption of validity is also strengthened by the commercial success of the Korter Patent. It is highly significant that there is no evidence that any of the patents cited by the defendants, achieved any commercial success or that they were even put into practice. So far as this record discloses, they were merely “dormant” “paper” patents.

II

**RE: ALLEGED FILE WRAPPER
ESTOPPEL**

There is no foundation in the record for the contention that the specifications in the first ("co-pending") application were "abandoned" by the patentee in making the second application.

The only place where the word "abandoned" is to be found, appears on the Clerk's certificate, certifying the record (DX 28). On the face of the certificate, the Clerk recited,

"Abandoned Application of Louis J. Korter."

The Clerk's certificate is not a part of the "file wrapper" (Patent Office record). It merely certifies that the documents attached are true copies of the originals on file.

There is nothing **in the record itself** anywhere to support the statement of the Clerk that the application was abandoned. There is no Order, or any other document in the record, showing abandonment.

The record (DX 28) shows on its face that **the proceeding was still pending and undisposed of when the amended application was filed** (DX 29). The amended application was filed January 9, 1950. The file wrapper on the first application (DX 28) shows that various proceedings were taken under that application subsequent to the filing of the amended application as late as September, 1952.

Document No. 3 in DX 29 is the amended application. It recites:

"This invention relates generally to shingles and particularly to aluminum shingles as set forth in detail in my co-pending application, Serial No. 766,332, filed September 26, 1947, over which the shingle shown herein is an improvement."

This establishes that the amended application is a continuation of the co-pending application. It incorporates the elements in the co-pending application and treats the amendment as an improvement on the former application and precludes the contention that anything presented by the co-pending application has been abandoned. Throughout defendants' brief, the "co-pending" application is referred to as the abandoned application and their arguments are predicated on that hypothesis.

The Patent, when issued, incorporated the above quoted statement (column 1, lines 1 to 5 of the patent), and was the equivalent of an adjudication by the Patent Office that the latter application was a continuation of the former and not an abandonment of anything. It certainly was not an abandonment of anything that was carried forward and reiterated in the amended application.

The first application was only abandoned in the sense that after the issuance of the Patent on the "co-pending" and "amended" applications, there were no further proceedings on the co-pending application because the elements described in the co-pending application had been incorporated into and made an integral part of the amended application

and, together, formed the combination of elements on which the patent was issued.

Document No. 40 (DX 28), recites that a civil action was brought on **December 5, 1952**, in the United States District Court for the District of Columbia involving "this application." (Referring to first application.)

It then recites:

"The above civil action was terminated on Stipulation for Dismissal signed by counsel on March 13, 1953, with prejudice as to claims set out in the complaint **but without prejudice as to any claims the Patent Office may allow or has allowed in the application of the plaintiff here involved, or in any other application.**"

Appellants called attention to a part only of this stipulation on page 19 of their Reply Brief and stated,

"it was dismissed with prejudice."

But they **significantly omitted to call attention** to the provision that the dismissal was to be

"without prejudice as to any claims the Patent Office may allow or has allowed in the application of the plaintiff here involved, or in any other application."

This reservation is of great importance because at the time this stipulation was made (March 13, 1953), the **Patent Office had already given notice (February 13, 1953) that the patent was allowed.** (DX 28, documents 81 and 83.)

The former document is the official "notice of allowance" and the second document recites:

“Date of Notice of Allowance
Feb 13—1953
Patent to be issued to
March 17—1953”

The file wrapper upon the amended application, DX 29, does not contain any indication or suggestion of the “abandonment” of any elements of the earlier application. In the contrary, the amended application, which is incorporated into and is a part of the patent itself, recites (Column 1, lines 1 to 5):

“This invention relates generally to shingles and particularly to ALUMINUM SHINGLES as set forth in detail in my **co-pending application, Serial No. 776,332**, filed September 26, over which the shingle shown here is **an improvement.**”

The reference in the patent to the various drawings and the specifications and the recitation of the elements included in the claim, are substantially the same as in the earlier application. Both applications recited, as one of the objects, the matter of the **drainage of condensation.**

It is apparent that the Patentee did not abandon the first application or the elements set forth therein, but consistently asserted the claim. The patent itself makes the first application and the claims inserted therein, insofar as they are re-asserted in the amended application, an integral part thereof and the patent was issued thereon.

It is manifest that if the first application and the specifications contained therein had been abandoned, the Patent Office would not have issued the

patent in his present form. It would not have permitted the reference to

“my co-pending application, Serial No. 776,332 over which the shingle shown herein is an improvement.”

This record does not establish abandonment. It establishes that the Patent Office included the elements recited in the earlier application insofar as they were substantially repeated in the amended application and incorporated into the patent.

The granting of the patent was an adjudication by the Patent Office that the combination of all the elements recited in the patent, including those originally in the first application, was patentable over the references cited in the patent without any limitation resulting from the prior proceedings. (**Overland Motor Co. v. Packard Motor Co.**, 274 U.S. 417.)

Since there is no abandonment, there is no file wrapper estoppel with respect to the elements carried forward into the second application.

There being no file wrapper estoppel, plaintiff is entitled to the full range of equivalents which the patent, on its face asserts, without the limitations which file wrapper estoppel would impose.

Appellants' entire argument on the question of validity, anticipation and infringement, are predicated on the unwarranted repeated assertion in the brief that the first application and the specifications therein were “abandoned.”

Section 120 of the Patent Codification Act (35 U.S.C.A. 120) which became effective January 1,

1953, and made applicable to pending applications and applications filed thereafter (**Section 293. Sec. 4. (a)**), precludes the assertion of the **file wrapper estoppel**. It provides:

“An application for patent for an invention disclosed in an application previously filed shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application and **if it contains or is amended to contain a specific reference to the earlier filed application.**”

In the case at bar, the amended application was filed:

- (a) “before the patenting”;
- (b) before abandonment of or termination of proceedings on the first application;
- (c) the Patentee was entitled, under the Act, to the “filing date of the first application”; and
- (d) the patent “contains a specific reference to the earlier filed application.”

The granting of the patent over the cited patents, is an adjudication by the Patent Office that the combination of the elements recited therein, produced a new and useful result not found in any of the cited patents.

The Patent Office did not determine that the “hole” produced the “new unitary result.”

The granting of the patent for the combination over the patents cited therein, some of which the patent Office formerly cited in rejecting some claims, is consistent only with the conclusion:

- (a) that the former rejections were based on the ground that every element was considered by itself as a separate claim and as such, was not patentable over the cited patents; and
- (b) that the later granting of the patent over the same cited patents, was warranted because it covered all of the elements **in combination**. On this basis, the former rejection of the claims and later granting of the patent on all of the elements in combination, was consistent with the former action of the Patent Office.

The granting of the patent did not, under these circumstances, constitute a rejection from the combination of the elements which were formerly presented as separate claims and rejected as such.

It was, in effect, a re-examination of the true basis of the applications together and a recognition that the Patent Office should have considered all of the elements as a part of a combination instead of individual separate claims. **Bianchi v. Barili**, 168 F. 2d 793, 9th Cir., and other cases decided by this Court and the Supreme Court from which we quoted at pages 9 to 16 of this brief.

In addition to the authorities cited at pages 20 to 22, and Appendix, pages 4a to 7a, of Appellee's former brief, we respectfully invite attention to the following authorities:

In **Overland Motor Co. v. Packard Motor Car Co.**, 274 U.S. 417—47 S. Ct. 672, it appeared that after a certain claim was rejected by the Patent Office as anticipated by prior patents, the patentee cancelled his claim and thereafter filed a "divi-

sional application" in which he included, as an element, the claim formerly rejected, along with other elements and a patent was issued thereon. It was contended that plaintiff was estopped from claiming the benefit of the element formerly rejected. The Supreme Court held:

"It is quite true that after such rejection the Commissioner of Patents might have refused to consider his divisional application as he made it without suggestion or consent by the Patent Office. In a qualified and limited sense a claim rejected as this was constitutes *res judicata* in favor of the Government and against the applicant. This is fully explained by Judge Morris in *Re Barratt's Appeal*, 14 App. D. C. 255, in speaking of a case presenting a similar question:

.

"In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper to do so, entertain and adjudicate a second application for a patent after the first application has been rejected."

.

"This qualification is approved in the cases of *In re Fay*, 15 App. D. C. 517, *In re Edison*, 30 App. D. C. 321, 323, and in *Gold v. Gold*, 34 App. D. C. 229.

"As the **Patent Office**, by granting the patent, must be held to have **waived any objection** to the applications **on the ground that the claim allowed had been rejected before** by that Office, there is no reason why the appellees below should not be allowed to avail themselves of the waiver. We answer the first question in the negative."

In *Dean Rubber Mfg. Co. v. Killian*, 106 F. 2d

316 (8th Cir.), under conditions similar to those in the case at bar where an amendment was made after rejection of original claims for anticipation, the Court held:

“The language of the amended claims is, in some respects, more definite than that employed in the original claim, but reading all of the claims together, they are not essentially different than in their original forms. We find no evidence of a surrender of any substantial claim as a condition upon which the patent was issued. **We cannot agree with defendants’ contention as to file wrapper estoppel.**” (Emphasis supplied.)

In *Tansel v. Higonet*, 215 F. 2d 457 (U.S.C.C. P.A.), the Court held:

“Tansel in filing his second and third applications **made known** therein his **intent not to abandon**, and he did not thereby abandon, the invention defined by the terms of his original application.” (Emphasis supplied.)

The patent in the case at bar, on its face, discloses that the inventor did not abandon the elements described in the earlier application for it expressly refers to

“my co-pending application,”

expressly states that it is merely an “improvement” over the earlier application and restates the elements contained in the co-pending application.

In *Hunt Tool Company v. Lawrence*, 242 F. 2d 347 (5th Cir.), under similar conditions, the Court held:

“The district court held that the doctrine of file wrapper estoppel is not available here

to limit the construction of the claims of appellees' patent. With this we agree. In neither application was there any revision made in the allowed claims, though in both the patent office originally disallowed and the inventor later withdrew one or more claims."

In the case at bar, there was no revision or abandonment of the elements described in the earlier application. They were **all included in the amended application** which is obviously the highest evidence that the inventor did not intend to abandon the elements. The Patent Office, in granting the patent, of necessity, included all of the elements in the coverage because it did not require any exception or limitation.

The file wrapper estoppel argument is predicated, in part, upon excerpts from **arguments or statements made by Counsel** for the inventor during the proceedings in the Patent Office. It is well settled that estoppel cannot be predicated thereon.

Parker Rust Proof Co. v. Ford Motor Co., 6 F. 2d 649;

Catalin Corporation v. Catalazuli Mfg. Co., 79 F. 2d 593 (2nd Cir.);

A. G. Spalding & Bros. v. John Wanamaker, 256 Fed. 530 (2nd Cir.);

Auto Pneumatic Action Co. v. Kindler & Collins, 247 Fed. 323 (2nd Cir.);

Byers Mach. Co. v. Keystone Driller Co., 44 F. 2d 283 (6th Cir.).

In 69 C.J.S. 725, Sec. 212, the text says:

"The fact that a patentee voluntarily introduced into his application by amendment broader claims, which were allowed, does not deprive him of the right to have them con-

strued as broadly as their language implies, or to claim a structure which comes within them, although not within the original claims; and claims allowed after their amendment and drawn to read on what a competitor had just put out cannot be disregarded where they are supported by the original specifications."

The case of **Protective Closures Co. v. Clover Industries**, 129 F. Supp. 941, is particularly applicable to the case at bar. The case involved a combination patent. A number of claims in the original application were disallowed by the examiner, but were later included in an amended application as a **part of the combination** in conjunction with the added element. Defendant made the same contention as does the defendant in the case at bar, to-wit, that the patent must be limited to the new elements and to exclude the elements originally rejected. The contention was rejected and the Court held:

"In *International Cellucotton Products Co. v. Sterilek Co.*, 94 F. 2d 10, 12, the Court, speaking through Judge Learned Hand, said, in part:

" 'When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element so introduced. * * * Nor is there any reason to impose upon him the same consequence as though he had formally so conceded; it is enough that he has freed the art except as the claim reads, and that he has surrendered any power under the doctrine of equivalents to resume what he has given up. He has done nothing which need prevent him from insisting in support of the claim

as allowed that his invention was broader than the examiner supposed; he is not confined to the examiner's reasoning or committed to his mental processes.'

"That was a suit for infringement of a patent. While the application was pending, the examiner cited a reference against the claims and to escape this the applicant amended his claim and made some change in the machine. Defendant urged that by so limiting his claims, the applicant had conceded that the prior art anticipated his claims with the sole exception of his interpolated feature.

"In *Texas Co. v. Globe Oil & Refining Co.*, 112 F. Supp. 455, in the prosecution of the patent the claims had been amended and the same contention was there made as is here contended. The defendant contended that the validity of the claims must be wholly judged by the element added by amendment following rejection of certain claims. The Court at considerable length quotes and discusses several cases, and in conclusion it said, 112 F. Supp. at page 479: 'In my opinion, the law should not and does not, require that the novelty of Behimer's invention be judged on the basis alone of the added element of the pump.' "

In *R. Hoe & Co. v. Goss Printing Press Co.*, 30 F. 2d 271 (2nd Cir.), the Court held:

"We have repeatedly said that we will not look to the file wrapper for estoppels, except in case the patentee tries to expand his claim by omitting an element which leaves it identical with one which he had abandoned. *Westinghouse Electric v. Condit Electrical Co.* (C. C. A.) 194 F. 427, 430; *Auto Pneumatic Co. v. Kindler & Collins* (C. C. A.) 247 F. 323, 328; *Spalding v. Wanamaker* (C. C. A.) 256 F. 530, 533, 534."

In the case at bar, plaintiff does not seek to eliminate any element in order to expand its combination claim. The presence of a "hole" in the gutter is not included as an element in the combination. The patent only provides for a "drain slot" disposed in the gutter. It does not require that the drain slot should be in the form of a hole or formed by cutting the corners at the end of the shingles. The "drain slot" can be in any form or shape and located anywhere in the gutter.

In **Smith v. Snow**, 294 U.S. 1—55 S. Ct. 279, the Court held:

"We find nothing in the file wrapper to suggest that any addition was made to claim 1 to restrict the patent to any particular order of arrangement of the eggs or any particular direction or means of control of the current of air, other than its velocity, and nothing to estop the patentee from asserting that the claim is not restricted by such features. See **Baltzley v. Spengler Loomis Mfg. Co.**, 262 F. 423, 426 (C. C. A. 2d); **National Hollow B.-B. Co. v. Interchangeable B.-B. Co.**, 106 F. 693, 714 (C. C. A. 8th). It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader claim 1. **Westinghouse Electric & Mfg. Co. v. Condit Electrical Mfg. Co.**, 194 F. 427, 430 (C. C. A. 2d)."

In **Baltzley v. Spengler Loomis Mfg. Co.**, 262 Fed. 423 (2nd Cir.), the Court held:

"Having from this viewpoint examined the file wrapper, we are of opinion that the patentee's disclosure stated fully and at first facts sufficient upon which to ground the claims in

suit, and **such claims or their equivalents he never receded from.** Many claims, first propounded, were obviously too broad; but Baltzley **never 'accepted limitations** imposed by the rejection of broader claims' and affecting the claims in suit. The residuum is ample for the purposes of this case. See *Goodwin, etc. Co. v. Eastman, etc., Co.* (D. C.) 207 Fed. 357, affirmed 213 Fed. 231, 129 C. C. A. 575."

Korter did not, in the earlier application, claim that each element was patentable in and of itself. The earlier rejections were predicated on the ground that each of the elements rejected (as separately patentable) were anticipated by one or more of the cited patents.

But the examiners did not consider all of the elements in combination and did not, by any of their rulings or rejections, hold that the elements in combination were not patentable. None of the prior patents were cited as anticipation of such a combination to produce the objective described in the application.

In short, there never was any prior ruling that the combination was anticipated by anyone of the cited prior patents and, consequently, there is no foundation for the contention that Kortor adopted a ruling that the combination was anticipated and abandoned such a combination.

The amended application and the conferences with the Examiner demonstrated to the Patent Office that Kortor was not seeking a patent on each claim, but was seeking a patent on a single claim which consolidated the several elements to produce

the new unitary result. The Examiner ultimately became convinced that **it was the combination** that was new and allowed the patent over the patents cited therein (which he formerly held anticipated some of the individual elements) because they did not involve a combination to produce a new result.

As was said in **Florence-Mayo Nuway Co. v. Hardy**, 168 F. 2d 778,

“There is nothing in the prior art which anticipates this combination.

.

What was new was the combination of these (old elements) with a device for delivering the outside air under the hood and over the burners. It was this that accomplished the desired result; and such a combination was nowhere shown in the prior art. As in most infringing cases of this sort, many of the things which the patentee has brought together can be found separately in the art; but nowhere are they found in the combination which brought success to the patentee.”

The granting of the patent on the “co-pending” and “amended” application was not a determination that the patent allowed, covered the drain slot or “hole” only, or a rejection of the other individual elements. It was a determination that all of the elements, including the drain slot **in combination**, was patentable and was not anticipated by the references cited in the patent.

The “drain slot,” as an element, was common to both applications. Both disclosed a “slot.” The “co-pending” application used the term “diagonal slot.” In the amended application, the term “drain slot” is

used. It was not limited to a drain slot accomplished by making a "hole" near the end of the gutter as distinguished from a drain slot accomplished by cutting away the corners of the shingle. The drain slot was not required to be of any particular shape or form.

The drain slot in either form could not, in itself, accomplish the object of the invention. It was the combination of all of the elements leading to the drain slot that combined to bring the condensation water to the slot in any shape that could produce the desired effect.

The addition of the oval shaped opening did not displace, and was not a substitute for, any other element. It was merely an "improvement" of one element—the slot—to further insure the drainage.

The granting of the patent on the single combination claim was not abandonment or rejection of any of the elements that are common to both applications.

Taking the record as a whole, it demonstrates that the Patent Office did not regard each of the elements patentable by itself, but concluded that **the combination** of all of the elements was **patentable** and not anticipated by references cited therein.

That determination was in harmony with the teachings of the cases cited at pages 9 to 16 of this brief and at pages 20 to 22 of the main brief.

The combination claim was not rejected in any prior ruling and consequently, there is no foundation for file wrapper estoppel.

Drainage through a "slot" was the ultimate object of the invention. The other elements brought the water to the slot. Whether the slot is in the form of a hole in the end of the gutter or in the form of a slot at the end of the gutter formed by cutting away the corner, is immaterial.

In **Florence-Mayo Nuway Co. v. Hardy**, 168 F. 2d 778, a case involving a combination patent, the Court held:

"The fact that there are one or two minor differences

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manifestly does not avoid infringement" (citing several cases).

In that case, defendant contended that certain of the elements were abandoned because the Examiner had rejected claims describing said elements as shown in the prior art. The Court held that this did not affect the validity or the **scope of the combination patent which included the said elements**.

In **New York Scaffolding Co. v. Whitney**, 224 Fed. 452 (8th Cir.), the Court held:

"One who does not abandon, but insists upon and sustains, his first claim, is not estopped, and one who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references is not thereby estopped from claiming and securing by an amended claim every novel and useful improvement that is not described in those references."

If the Patent Office had deemed the first application as abandoned and had treated the amended application as claiming a patent on the "hole" only,

it never would have issued the patent because that in and of itself was not patentable.

The issuance of the patent on the co-pending and amended applications is consistent only with the conclusion that the Patent Office treated the drain slot merely as an element in combination with all the other elements described in both applications and it was that combination that was patentable.

III.

RE: INFRINGEMENT

Appellants' specification of error with respect to infringement is as follows (Appt. Br. 9):

- "2. Does the accused structure infringe when it does not have an element (drain slot) expressly called for in the claim of the patent?"

This specification limits the claim of non-infringement to the alleged absence in the accused shingle of **only one element**, to-wit, the "drain slot." It follows that if the accused shingle does have a "drain slot" or its reasonable equivalent, the defense of non-infringement fails.

It is not argued that the accused shingle does not have a "drain slot." Bergman admitted that it does have a drain slot and the accused shingle shows it.

It is only argued that the accused shingle did not have a "hole" in the gutter and that this avoids infringement.

The true question, therefore, is:

"Does the accused shingle infringe when it

does not have a hole in the gutter which is **not** called for in the claim but does have a drain slot at the corner.

The claim does not describe a "hole" disposed in the gutter.

The patented shingle describes, as one of the elements of the combination,

"a **drain slot** disposed in the gutter of said shingle for draining water therefrom" (Column 3, lines 4 and 5).

The accused shingle shows a "drain slot" disposed in the gutter also created by cutting away the corner of the gutter. The only difference in the drain slot so formed in the accused shingle and the drain slot so formed in the patented shingle is that the slot is somewhat wider in the accused shingle.

In Figure 3 of the Patent **Specifications**, the slot, formed by cutting the corner of the gutter, is described as

"the **drain slot** which provides the basis of the invention" (Column 1, lines 18 and 19).

The same slot, formed in the same way, is present in the accused shingle except that it is a little wider, accomplished by cutting a little more of the gutter corner.

Bergman admitted in the pre-trial deposition (DX 4, p. 14) that this shingle has a

"drain slot on the end."

Bergman also admitted at the trial on direct examination (Tr. 232) and again on cross-examina-

tion (Tr. 237) that the accused shingle has drain slots on the end.

Figure 21 in the Patent **Specifications** also shows a "hole" in the gutter as "a drain slot" (Column 1, line 55). The specifications provide that

"more slots may be employed without departing from the spirit of the invention."

The claim, however, only requires a
"drain slot disposed in the gutter."

It does not compel the use of drain Slot 21 (the hole). It is optional.

Drain slot 3 or 21, or both, or more, can be used
"without departing from the spirit of the invention." (Patent col. 2, lines 1 and 2.)

Bergman used drain slot 3 in the accused shingle. That was merely a choice permissible under the patent. He dispensed with the use of the optional drain slot 21 by making his drain slot 3 a little wider and thereby sought to accomplish what drain slots 3 and 21 accomplished together, namely, provide for more drainage.

This use of the drain slot 3 in the accused shingle is obviously a direct infringement and consequently, there is no need for invoking the doctrine of equivalents which presupposes a resort to another means to accomplish the same purpose.

Assuming, without admitting, that the use of the drain slot 3 without drain slot 21, is not a direct infringement, the enlargement of the opening, drain slot 3, is, in legal contemplation, the equivalent of the use of the two openings together.

The Court below found as a fact (Finding No. VI, Tr. 48-49) that the accused shingle
 “infringed upon plaintiff’s patent.”

The Court below also found as a fact (Finding No. XII, Tr. 50) that there was no file wrapper estoppel by reason of the
 “co-pending application for said Letters Patent.”

The Court also found (Finding No. XV, Tr. 51) that

“Korter is entitled to a reasonable range of equivalents.”

Rule 52 of the Federal Rules of Civil Procedure provides that

“Findings of fact shall not be set aside unless clearly erroneous . . .”

This Rule is particularly applicable to findings of fact on the issue of infringement in patent cases.

Brodie Co. v. Hydraulic Press Mfg. Co., 151 F. 2d 91 (9th Cir.);

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605—70 S. Ct. 854;

University of Illinois Foundation v. Block Drug Co., 241 F. 2d 6 (7th Cir.).

The findings of infringement are supported by the record which includes:

- (a) a demonstration of the operations of the accused shingle in comparison with the patented shingle;
- (b) by a comparison of the structure of the accused and patented shingles;
- (c) by expert testimony;
- (d) by the nebulous character of the testimony

of defendants Bergman and Langville which has little or no probative value.

Defendant Langville, although purporting to give expert testimony on the question of validity and anticipation, **did not give any testimony whatsoever on the question of infringement.**

Defendant Bergman testified with respect to the drain slot as follows (Tr. 232):

"A. Well, in our corner, the right and left-hand corner, provision is made to hook these shingles together. With this opening here it allows any moisture, if it forms, to drain off of this hole naturally, right through the seam here.

Q. Referring to the patented shingle, what do you find in the gutter of the patented shingle?

A. **I also find** a little opening on the end, **a drain slot.**

A. . . . Also, in locking ours together it will easily allow water to drain off at either end without any trouble at all."

On cross-examination, he testified (Tr. 237):

"Q. I believe you have also admitted, sir, that you do have a gutter at the bottom of your shingle, do you not?

A. Yes, sir.

Q. You also have a **drain slot** there, do you not, in the gutter?

A. Well, I have heard you call it a bleeder. I will call it a bleeder, or if you want to call it a **drain slot** you can. It is the edge of a seam.

Q. But **you called it a drain slot**, did you not, in the testimony that you gave here a short time ago?

A. Yes, I did. At that time I wasn't ac-

quainted with the technical point, what you were calling that. Now I understand it is called a bleeder joint."

Mr. Richardson testified with respect to the **drain slot in the accused shingle** (Tr. 104):

"Now that **drain slot can be seen right through there**. This is the cut-off end of this thing, and the whole thing has been enlarged to open up and make adequate drainage at all times."

(Tr. 105):

"Q. Will you show the Court where on Mr. Bergman's shingle there is this drain slot disposed in the gutter of the shingle for draining water therefrom?

A. Yes, sir. It is right here (indicating).

Q. How does that slot compare with any other slot that is shown on Mr. Korter's shingle? Is it narrower or wider, or just how is it?

A. Well, it is obviously wider here. The normal way of making these interlock would be to **just clip the corner** and fold this rather closely at the corner. But in order to provide a definite drain slot this flat sheet has been clipped off enough to make this corner space here cut the corner off the shingle before they fold it."

Mr. Richardson then was permitted to demonstrate that the condensation water drains from the accused shingle in the same manner as from the patented shingle (Tr. 105 to 108). This was done by the use of a section of roof made up of patented shingles and another section of roof made up of the accused shingles. The demonstration showed that the drain slot in the accused shingle performed the same function as the drain slot or slots in the pat-

ented shingle. At the conclusion of the demonstration, he testified (Tr. 110):

“Q. And do you find that the functions of these elements in the Bergman shingle cooperate to get rid of this water condensation in substantially the same manner as the similar elements of the Korter shingle or the Korter patent?

A. I would say that they were substantially so, yes.”

In the original application, the drain slot consisted only of the opening resulting from cutting the corner of the gutter. When the amended application was filed, the elliptical hole in the gutter was shown in the drawing in addition to the slot at the end. **But the claim did not require the hole as an element.** The claim merely provides for “a drain slot disposed in the gutter.” Both openings perform the same function, to-wit, draining the condensation water from the gutter. Individually or together, they constitute the drain slot or means of draining the water from the gutter. The claim did not require the drain slot to be in any particular, form, shape, size or location. Any opening that performs that function of draining the water is a “drain slot” within the meaning of the claim.

The addition of the hole was merely an “improvement of the drain slot (Patent column 1, line 5).

The opening at the end of the gutter in the accused shingle performs the function of the “drain slot” in every sense of the word. It certainly is the same as the corner opening in the patented shingle

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A. I would say that they were substantially so, yes.”

In the original application, the drain slot consisted only of the opening resulting from cutting the corner of the gutter. When the amended application was filed, the elliptical hole in the gutter was shown in the drawing in addition to the slot at the end. **But the claim did not require the hole as an element.** The claim merely provides for “a drain slot disposed in the gutter.” Both openings perform the same function, to-wit, draining the condensation water from the gutter. Individually or together, they constitute the drain slot or means of draining the water from the gutter. The claim did not require the drain slot to be in any particular, form, shape, size or location. Any opening that performs that function of draining the water is a “drain slot” within the meaning of the claim.

The addition of the hole was merely an “improvement of the drain slot (Patent column 1, line 5).

The opening at the end of the gutter in the accused shingle performs the function of the “drain slot” in every sense of the word. It certainly is the same as the corner opening in the patented shingle

except that in the accused shingle the space is made wider by cutting more of the gutter corner which results in a greater flow of water and performs the same function as the two openings in the patented shingle.

The sole contention of the defendants that the accused shingle does not infringe is predicated on the presence of the hole in the gutter in the patented shingle and not in the accused shingle. But since the function of the openings in both shingles is to drain the water from the gutter, the presence or absence of the hole in the accused shingle, is of no consequence. Both perform the function of a drain slot.

In 69 C.J.S. 873, Sec. 301, the rule is stated as follows:

“Where form is not of the essence of the combination, **mere differences in form do not avoid infringement** where the mode of operation is the same and the **same result is obtained** by the same or equivalent means, and such rule applies even where the claim of the **combination** is narrowly construed, if the infringing combination is within the narrow construction.”

At page 876, the text says:

“The rules relating to equivalency generally, as discussed supra § 299, apply to **patents of combinations**, and the **substitution of an equivalent for an element or ingredient in a patent for a combination does not avoid infringement**. A patentee cannot claim equivalency in respect of an element that he has abandoned at the request of the patent office in order to obtain a patent. In order to constitute

equivalency under this rule the element or ingredient substituted for the omitted element or ingredient of the combination **must perform the same function in substantially the same way**, and must have been known at the date of the patent as a proper substitute." (Emphasis supplied.)

Defendants' argument on the question of infringement is predicated on the hypothesis that the only element involved in the patent is the "hole" and that all of the other elements must be disregarded and not considered a part of the combination, on the alleged ground of file wrapper estoppel.

As to the contention that the element involved is merely a "hole" in the gutter, the obvious answer is that the claim does not describe any element consisting of a "hole" in the gutter. It describes a "drain slot" disposed in the gutter and if the hole, by itself or in conjunction with the opening at the end performs the function of draining the condensation water from the gutter, there is present the required "drain slot."

As to the latter contention that all of the elements must be disregarded on the ground of file wrapper estoppel, it has already been demonstrated that there is no file wrapper estoppel involved in this case, the principal reason being that none of the rulings on the earlier application involved the "combination" of the elements and the new "unitary result" accomplished thereby.

For the purpose of determination of the issue of infringement, the validity of the patent must of course, be conceded or assumed and its scope

determined from the language of the claim **as written** in the Patent.

The patent as written does not cover a "hole" only, or a "drain slot" only. It covers a number of elements, one of which is a "drain Slot" (not a hole), all of which, in combination, produce the new unitary result.

In *Angelus Sanitary Can Mach. Co. v. Wilson*, 7 F. 2d 314 (9th Cir.), the defense of non-infringement was predicated on the same conditions presented in the case at bar, to-wit, limitation of the scope of a combination patent predicated on file wrapper estoppel and limited construction of the language of the claims by reason thereof. Defendant claimed that the **absence of an element in the accused device** established the non-infringement. The Court held:

"It is on the combination of the parts and features of the whole machine that patentees claim a monopoly.

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"Appellants rely much upon the file wrapper which shows that Wilson's claim 2 (originally claim 6) was rejected and then amended to avoid references (Brenzinger, No. 813,482, Black, No. 858,785, and Wegner, No. 1,104,751) cited against them.

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"In *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, supra, the court, through Judge Sanborn said: 'The **description in a specification or drawing of details** which are not, and are **not claimed as, essential elements of a combination**, is the mere pointing out of the better method of using the inven-

tion. * * * A reference in a claim to a letter or a figure used in a drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that element there shown, unless that particular form was essential to, or embodied the principle of, the improvement claimed.'

"We regard claim 2, in the element of encircling means, as entitled to a construction which includes a fairly liberal range of equivalents. The difference in the use of a mechanical equivalent does not avoid infringement. In *Eibel Process Co. v. Paper Co.*, 261 U.S. 45, 43 S. Ct. 322, 67 L.Ed. 523, the court, through the Chief Justice, clearly reiterated the doctrine that where an inventor, though not a pioneer in the sense of having created a new art, has made a very useful discovery which has substantially advanced the art, his patent, though but an improvement on an old machine, may be entitled to liberal treatment. That same principle was applied by this court in *Smith Cannery Co. v. Seattle Astoria Iron Works (C.C. A.)*, 261 F. 87 (9th Cir.). Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form, or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain the results by the use of the same or equivalent mechanical means (citing cases). By varying the encircling means, but producing the same results in substantially the same manner, there is infringement." (Emphasis supplied.)

In *Vallen v. Volland*, 122 F. 2d 175 (8th Cir.), the Court held:

"Changing the relative position of parts does not avoid infringement where the transferred

parts perform the same respective functions after change as before."

In *Imhaeuser v. Buerk*, 101 U.S. 647, the Court held:

"Equivalents may be claimed by a patentee of an invention consisting of a combination of old elements or ingredients, as well as of any other valid patented improvement, provided the arrangement of the parts composing the invention is new, and will produce a new and useful result.

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"Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents, by which is meant that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which, in the same arrangement of the parts, will perform the same function, if it was well known as a proper substitute for the one described in the specification at the date of the patent." (Emphasis supplied.)

In *Jeoffroy Mfg. Co. v. Graham*, 206 F. 2d 772 (5th Cir.), the accused device did not have one of the elements specifically described in the patent, to-wit, "the Graham Opening," but did have a "substantial counterpart of these omitted elements." The Court held:

"We conclude that such alterations in the form of mechanically equivalent elements do not avoid infringement where, as here, the accused device exhibits the essential elements of the patent claims, for 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they

are the same, even though they differ in name, form or shape.’ ” (Emphasis supplied.)

We have heretofore demonstrated that the Korter shingle was the first metal shingle that dealt with the problem of draining condensation water from the under-side of the metal shingles to the outside of the roof. No other shingle that was called to the attention of the Court dealt with that problem.

The Belding Patent recognized the problem caused by condensation and the seriousness of the problem, but it did not undertake to provide for the **drainage** of the condensation water. It undertook to **“prevent” the formation** of the condensation by providing for ventilation.

The Korter shingle marked an important and decided advance in the art of the manufacture of metal shingles and it is now well settled that a patent that makes a distinct advance in the art is entitled to a liberal range of equivalents.

In **Jay v. Suetter, 32 F. 2d 879 (9th Cir.)**, the Court held:

“ ‘Where a combination patent makes a distinct advance in the art to which it relates, as does the appellant’s invention here, the term **“mechanical equivalent”** should have a reasonably broad and general interpretation.’ **Smith Canner Mach. Co. v. Seattle-Astoria Iron Works (C.C.A.) 261 F. 85.**”

In **Smith Cannery Machines Co. v. Seattle-Astoria Iron Works, 261 Fed. 85 (9th Cir.)**, the Court held:

“Where a combination patent marks a distinct advance in the art to which it relates, as does the appellant’s invention here, the term ‘mechanical equivalent’ should have a reasonably broad and generous interpretation, and protection against the use of mechanical equivalents in a combination patent is governed by the same rules as patents for other inventions. *Imhaeuser v. Buerk*, 101 U.S. 647, 25 L.Ed. 945.”

In ***Bianchi v. Barili***, 168 F. 2d 793 (9th Cir.), the Court held:

“ ‘Where an invention undoubtedly marks a substantial advance in the art, the patent is to be given a reasonably liberal construction so as to secure the inventors the rewards to which they are entitled.’ ”

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In ***Hydraulic Press Mfg. Co. v. Williams, White & Co.***, 7 Cir., 165 F. 2d 489, 492, the court said.

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“ ‘One does not escape infringement by providing a **single element which fully responds to a plurality of elements in the patent.** (Case cited).’ ”

“So here, Bianchi did not escape infringement by putting all his cutters on one roller, for he thereby was ‘providing a single element which fully responds to a plurality of elements (i.e., **two cutting rollers**) in the patent.’ ” (Emphasis supplied.)

In ***Priebe & Sons Co. v. Hunt***, 188 F. 2d 880 (8th Cir.), the Court held:

“A primary or pioneer invention is entitled to a broad and liberal construction and to a broad and liberal range of equivalence and is not to

be limited to the precise device and instrumentality disclosed. *Dean Rubber Mfg. Co. v. Kilian*, 8 Cir., 106 F. 2d 316, certiorari denied, 308 U.S. 624, 60 S. Ct. 380, 84 L.Ed. 521; *Flowers v. Austin-Western Co.*, 7 Cir., 149 F. 2d 955; *Mason Corporation v Halliburton*, 10 Cir., 118 F. 2d 729."

The record establishes that a "hole" in the gutter is not an essential element. It is not provided for in the claim as one of the elements. The essential element in the claim is a "drain slot." Any formation that performs the function of a drain slot comes within the purview of the patent.

The drain slot in the accused shingle is the equivalent of the drain slot which is the essential element described in the patent and is an infringement thereof.

The admitted use of the widened drain slot was a direct infringement or the use of an equivalent to accomplish the same result contemplated by the patent and the absence of the hole in the gutter does not avoid infringement.

The case at bar comes within the purview of the decision in **Marks v. Polaroid Corporation**, 237 F. 2d 428 (1st Cir.). The Court held:

"Its finding (infringement) is based on the testimony of expert witnesses called by Polaroid who the court below found had made exhaustive scientific tests of Depix' material, and on moving pictures of Depix process shown in court. To be sure this evidence was contradicted by experts called by the plaintiff. Nevertheless the court below was certainly entitled to give controlling significance to the defendant's

evidence. Further discussion would serve no purpose. It will be enough to say that the District Court's **finding of infringement, resting** as it does **on substantial evidence** which the court below found convincing, is **not open to successful attack on appeal.**" (Certiorari denied. 77 S. Ct. 564.) (Emphasis supplied.)

IV.

RE: PERSONAL LIABILITY OF DEFENDANT BERGMAN

Since the former Brief of Appellee was filed, the case of **Marks v. Polaroid Corporation**, cited at page 67 of Appellee's Brief, was affirmed by the United States Court of Appeals for the First Circuit at **237 F. 2d 428**, and certiorari was denied, — U.S. —, **77 S. Ct. 564**. The Court of Appeals held:

"At this point consideration of the personal liability of plaintiff-appellant Marks' for Depix Corporation's infringement is in order.

"Depix was a small family corporation organized by the plaintiff-appellant and his brother. Both men with their mother were the only officers of the corporation and the three owned all of its stock through their ownership of the stock of another corporation which held all the stock of Depix. The District Court found that the plaintiff-appellant supervised and directed the building of the machines and equipment used by Depix in manufacturing its product, that he was thoroughly familiar with the details of the process employed by Depix and with its product, and that he was the patentee of the patents under which Depix allegedly operated and for the exploitation of which it was organized. On the basis of these facts the court

below found that Marks not only actively participated in the business of the corporation but also directly contributed to the corporation's infringement, which, the court said, would not otherwise have occurred. On the basis of these facts the court found the plaintiff-appellant to have been the 'guiding spirit' behind Depix' infringement and hence liable with it for the infringement complained of by Polaroid.

"The above facts certainly show that the plaintiff-appellant was more than merely an officer of an infringing corporation. They show that he, individually was the moving, active conscious force behind Depix' infringement. This is clearly enough to make him personally liable under general principles, see *Dean Rubber Mfg. Co. v. Killian*, 8 Cir., 1939, 106 F. 2d 316, 320, as well as under Title 35 U.S.C. § 271(b) which provides: 'Whoever actively induces infringement of a patent shall be liable as an infringer.' "

35 U.S.C.A. 271 (b) provides:

"Whoever actively induces infringement of a patent shall be liable as an infringer."

CONCLUSION

The judgment appealed from should be affirmed.

Respectfully submitted,

S. J. BISCHOFF,
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